

REMARKS

Claims 1, 3-7, and 9-11 are pending in this Application. By this Amendment, claims 1, 3, 5, 7, 9, and 10 have been amended, and claims 2 and 8 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Specifically, claims 1 and 7 have been amended to incorporate the subject matter of canceled claims 2 and 8, respectively, and claims 3, 5, 9, and 10 have been amended to correct their respective dependencies. No new matter is added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issue requiring further search and/or consideration (as the amendments amplify issues previously discussed throughout prosecution); (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection and during the January 29, 2008, telephone Interview with Examiner Phan. Entry of the amendments is thus respectfully requested.

The courtesies extended to the Applicants' representative by Examiner Phan during the telephone interview held on January 29, 2008, are appreciated. The reasons presented during the interview as warranting favorable action are incorporated into the remarks below and constitute the Applicants' record of the interview.

The Applicants also appreciate that the Office Action indicates that claims 5-6 and 8-11 contain allowable subject matter. As indicated above, the subject matter of allowable claim 8 is incorporated into claim 7, and claim 8 is canceled. Claim 7 should thus also be allowable for at least this reason.

I. Claims Define Patentable Subject Matter

The Office Action rejects claims 1-4 and 7 under 35 U.S.C. §102(b) as being anticipated by Watanabe (U.S. Patent No. 5,472,063). As claim 7 has been amended to incorporate the subject matter of allowable claim 8, and claim 2 has been canceled, the rejection as it pertains to claims 2 and 7 is now moot. To the extent that the rejection remains applicable to the remainder of the claims 1 and 3-4, as amended, the Applicants respectfully traverse this rejection, as follows.

Amended claim 1 recites, *inter alia*, “[a] power unit mounting assembling method for mounting a power unit . . . said method comprising in succession: a first step of assembling said power unit into said sub-frame in substantially the same position as in a mounted state on said car body frame by supporting said power unit via an on-board mount on said sub-frame; a second step of attaching said sub-frame on which said power unit is mounted at the first step to said car body frame; and a third step of supporting said power unit via the mount on said car body frame, wherein said on-board mount is removed from between said sub-frame and said power unit after the end of said third step.”

The Applicants respectfully submit that Watanabe fails to disclose or suggest at least the feature “wherein said on-board mount is removed from between said sub-

frame and said power unit after the end of said third step,” as recited in amended claim 1.

Watanabe, in col. 9, lines 37-44, with reference to Fig. 9, discloses a front body of an automotive vehicle including a second mounting means 36 through which “a front end portion of a power-plant 5 is supported by a front portion of a center member 33,” and that includes “a mounting bracket 36a secured to the front end portion of the power-plant 5, a mounting bracket 36b secured to the center member 33, and an elastic rubber mount 36c for connecting the mounting brackets 36a and 36b together” (emphasis added).

In the Office Action and during the January 29, 2008, Interview, Examiner Phan asserted that the power-plant 5, the mounting bracket 36b, and the elastic rubber mount 36c correspond to the claimed “power unit,” “sub-frame,” and the “on-board mount,” respectively (not admitted). The Examiner further asserted that the claimed feature, “wherein said on-board mount is removed from between said sub-frame and said power unit after the end of said third step,” is unpatentable because it would have been obvious to one of ordinary skill to remove the rubber mount 36c from between the mounting bracket 36b and the power-plant 5 of Watanabe.

The Applicants respectfully disagree and assert that claim 1, as amended, is not anticipated or rendered obvious by Watanabe even if the claimed terms “power unit,” “sub-frame,” and the “on-board mount” are construed broadly by the Examiner to read on the power-plant 5, the mounting bracket 36b, and the elastic rubber mount 36c. In particular, there is nothing in Watanabe that would suggest removing the rubber mount 36c from between the mounting bracket 36b and the power-plant 5. In Watanabe, the

elastic rubber mount 36c exists for connecting the mounting brackets 36a and 36b together.

Moreover, the Applicants respectfully assert that, should the elastic rubber mount 36c be removed from the second mounting means 36, the support structure for the power-plant 5 may be compromised. Watanabe, in col. 8, line 65, to col. 9, line 8, specifically discloses that “[t]he power-plant 5 is supported by a rigid member of the front body, such as . . . by a center member 33, disposed under the power-plant 5 and extending in the lengthwise direction through a second mounting means 36 at its front end portion” (emphasis added). As such, one of ordinary skill in the art would not be motivated to remove the elastic rubber mount 36c because the proposed modification would destroy the intended purpose of the support structure of Watanabe.

The Applicants respectfully remind the Examiner that to qualify as prior art under 35 U.S.C. §102, a prior art reference must disclose each and every feature recited by a rejected claim. As noted above, Watanabe does not disclose, teach, or suggest each and every feature recited by claim 1.

Further, the Applicants respectfully submit that a *prima facie* case of obviousness under 35 U.S.C. §103(a) has not yet been set forth. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some

objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be some reason in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

The Examiner, during the interview, merely stated that the present invention is obvious in light of the cited reference. This is an insufficient showing of obviousness.

II. Conclusion

For at least the combination of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited reference. Accordingly, reconsideration and withdrawal of the outstanding rejection and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 107355-00145.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Bogdan A. Zinchenko', is written over a horizontal line.

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